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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/830,180	04/22/2004	Satoru Wakao	B588-685 (25815.701)	7729
26272 7590 06/25/2009 COWAN LIEBOWITZ & LATMAN P.C. JOHN J TORRENTE 1133 AVE OF THE AMERICAS NEW YORK, NY 10036				
EXAMINER PICH, PONNOREAY				
ART UNIT		PAPER NUMBER		
2435				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/830,180

Applicant(s)

WAKAO ET AL.

Examiner

PONNOREAY PICH

Art Unit

2435

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,7-11,13 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,7-11,13,15-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-3, 5, 7-11, and 15-17 are pending. Any well known art statements made in the prior office action(s) are taken as admittance of prior art as per MPEP 2144.03.

Response to Amendment and Arguments

Applicant's amendments were fully considered. Applicant's arguments were also fully considered.

The 112, second paragraph rejections are withdrawn in light of applicant's amendment and arguments. It is noted that as per applicant's explanation submitted on 5/11/09 and in light of the specification (pages 44-45), the terms "alternation unit" and "control unit" as recited in claim 1 are meant to be interpreted such that they could refer to software per se (i.e. "software program code"). Note that because these terms could refer to software per se, a rejection under 35 USC 101 is appropriate since software by itself does not fall within any of the four statutory categories of invention and by itself is incapable of any functionality to produce any result.

With respect to the rejections of claims 1-3, 5, 7, and 8, applicant argues that the terms "alternation unit" and "control unit" would not have been reasonably been interpreted to encompass per se, thus requests that the rejection be withdrawn. The examiner respectfully disagrees. In the second full paragraph on page 6 of the remarks submitted on 5/11/09, applicant clearly admits that these terms could be achieved by "software program code" and further pages 44-45 of the specification clearly discloses that there is at least one embodiment where "the software program code itself realizes

the functions of the ...embodiments". Applicant cannot admit that the terms' metes and bounds are clearly defined as including "software program code" to get around a rejection under 112, second paragraph and then attempt to overcome a rejection under 35 USC 101 by then disclaiming that the terms are not meant to encompass "software program code". Further, since pages 44-45 of the specification clearly provides a basis for interpreting the terms "alternation unit" and "control unit" as encompassing software per se, the rejection of claims 1-3, 5, 7, and 8 as being not statutory under 35 USC 101 is maintained since these claims are directed towards software per se when the claims are interpreted in light of the specification and in light of what applicant admits certain claimed terms to mean.

The rejection of claim 17 under 35 USC 101 is withdrawn due to applicant's amendment. It is noted that "recording medium" as defined in the specification (i.e. pages 6 and 45) are limited to statutory media.

With respect to the rejection of claim 1 under 35 USC 102, applicant argues that Ibaraki does not teach that data is copied when the digital signature is authenticated. The examiner respectfully submits that claim 1 does not state that copying is done when authentication is successful. Applicant appears to be arguing features that are not claimed. Claim 1 only requires that the first image file include authentication data used for storage for the control unit to control to store the second image file. Claim 1 does not make any requirement that authentication is successful or not for copying to occur. Applicant admits that Ibaraki teaches copying is or is not permitted depending on whether the digital signature is authenticated, thus the copying is dependent on the

presence of the digital signature. As such, the language of what is required by claim 1 is met by Ibaraki by applicant's own admittance of what Ibaraki teaches.

Applicant also argue that Ibaraki does not teach that in the case the digital signature is authenticated the data is copied, altered and stored without deleting the original, authenticated data. Again, the examiner respectfully submits that this feature being argued by applicant is not recited in claim 1, thus whether or not Ibaraki teaches this or not (and the examiner is not stating that Ibaraki does not teach it) is immaterial since this feature is not claimed.

Applicant's remaining arguments are dependent on what is traversed in the above two paragraphs. Since the basis of these remaining arguments has been traversed, the traversal of the remaining arguments flow from what is discussed in the above two paragraphs.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3, 5, and 7-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 is directed towards an apparatus comprising "an alteration unit" and "a control unit". Based on applicant's remarks submitted on 5/11/09 and based on what is disclosed in the specification (pages 44-45), it is clear that these units are software units per se. Software per se is not statutory since software per se does not fall within any of

the four statutory categories of invention and is not capable of any functionality which produces any result unless interrelated with some form of hardware. Claims 2-3, 5, and 7-8 are also not statutory because there is nothing recited in any of these claims which would require one to interpret that anything more than software per se is being claimed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 9, 13, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Ibaraki et al (US 6,434,538).

Claims 1, 9, and 17:

As per claim 1, Ibaraki discloses:

1. An alternation unit that alters a first image file stored in a removable storage medium in order to generate a second image file (col 7, lines 7-20 and col 12, lines 44-52).
2. A control unit that controls to store the second image file in the storage medium without deleting the first image file from the storage medium, if the first image file includes authentication data (i.e. digital signature f(M)) that is used to

authenticate whether the first image file has been altered (col 3, lines 9-55; col 4, lines 10-20; col 7, lines 7-20; col 11, lines 30-31; and col 12, lines 44-52).

Claim 9 is directed towards a method performed using the apparatus of claim 1 and is rejected for much the same reasons as claim 1. Claim 17 is directed towards a recording medium storing a computer program for realizing the method according to claim 9, which is performed using the apparatus of claim 1, thus is rejected for much the same reasons as claim 1. One skilled should appreciate that Ibaraki's invention utilizes a computer system, thus it is inherent that it have a recording medium storing a computer program to implement Ibaraki's invention.

Claims 5 and 13:

Ibaraki implicitly disclose wherein the alternation unit generates the second image file that does not include the authentication data, if the first image file includes the authentication data (col 6, lines 37-42 and col 7, lines 8-20). *An image could be a one-time copy image, which means that after it has been copied once, no more copy of the image is allowed to be made. This means that the second image does not include a copy of the digital signature $f(M)$, which would allow another image to be made from the second image. If this was not the case, then the image would not be "one-time copy".*

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3, 7, 10-11, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ibaraki et al (US 6,434,538).

Claims 2 and 10:

Ibaraki does not explicitly disclose wherein the second image file is stored in the same folder as a folder in which the first image file is stored. However, official notice is taken that storing a copy of a data or image file in the same folder as the original was well known in the art at the time applicant's invention was made. It would have been obvious to one skilled in the art to modify Ibaraki's invention such that the second image file is stored in the same folder as a folder in which the first image file is stored. One skilled would have been motivated to do so because where to store a copy of a data or image file is a matter of user preferences.

Claims 3 and 11:

Ibaraki does not explicitly disclose wherein the second image file is stored in a folder different from a folder in which the first image file is stored. However, official notice is taken that storing a copy of a data or image file in a different folder than the original was well known in the art. It would have been obvious to one skilled in the art to modify Ibaraki's invention such that the second image file is stored in a folder different from a folder in which the first image file is stored. One skilled would have been motivated to do so because where to store a copy of a data or image file is a matter of user preferences.

Claims 7 and 15:

Ibaraki does not explicitly disclose wherein a part of a file name of the second image file is the same as a part of a file name of the first image file. However, official notice is taken that this limitation was well known in the art at the time applicant's invention was made. In Windows systems as early as Windows 95, for example, if one made a copy of a file in the same folder as the original file, Windows by default names the copy "Copy of" plus the name of the original file. At the time applicant's invention was made, it would have been obvious to one skilled in the art to modify Ibaraki's invention according to the limitations recited in claims 7 and 15. It would have been obvious to one skilled in the art to do so because it would be nothing more than applying a known technique to a known device ready for improvement to yield predictable results.

Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ibaraki et al (US 6,434,538) in view of Kondoh et al (US 6,968,058).

Claims 8 and 16:

Ibaraki does not explicitly disclose wherein the image processing apparatus is an image sensing apparatus. However, Kondoh discloses the limitation (Fig 1, camera 100). At the time applicant's invention was made, it would have been obvious to one skilled in the art to modify Ibaraki's invention such that the image processing apparatus was an image sensing apparatus/camera as per Kondoh's teachings. It would have

been obvious to one skilled in the art to modify Ibaraki's invention to be a camera as per Kondoh's teachings because simple substitution of one known element (i.e. type of image processing apparatus) for another to yield predictable results is obvious.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PONNOREAY PICH whose telephone number is (571)272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.